

The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

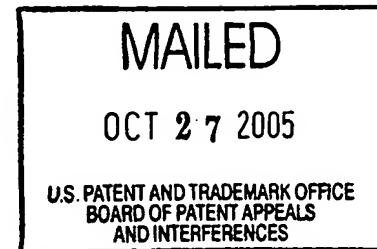
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JON A. BREWSTER, KENNETH W. CRANGLE,
ALOKE GUPTA, ROBERT M. MILLER,
EDMUND B. NEUMANN, MICHAEL L. ROBERTS
AND PIETER J. VAN ZEE

Appeal No. 2005-1728
Application No. 09/325,040

ON BRIEF



Before: KRASS, RUGGIERO, and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 22, 33 through 48 and 77 through 85. For the reasons stated *infra* we affirm-in-part the examiner's rejection of these claims.

Invention

The invention relates to a system for automatically transmitting an electronic document to a printing device in accordance with a printing schedule. See page 3 of appellants' specification. The document is printed at the print device without user intervention. A user profile, which contains information about the recipient of the document, is updated when a document is printed at the device. The user profile is also used to select advertising that can be printed at the printer. Further, the information in the user profile can be used to determine if a product for the user is to be subsidized. See page 4 of appellants' specification.

Claims 1 and 81 are representative of the invention and are reproduced below:

1. In a document delivery system having a document capable of being operatively coupled to a printing device, a method of printing the document on the printing device comprising the steps of:
 - storing a print schedule with an indication that the document should be printed at a user requested time;
 - automatically requesting, without user intervention, the document based on the print schedule;
 - transmitting the document to the printing device; and
 - causing automatic printing, without user intervention, the document on the printing device.
81. A method, comprising the steps of:
 - electronically monitoring by a document server the usage of a printing device; and
 - subsidizing the purchase of a product that is depleted upon the usage of the printing device, based on the electronically monitoring step.

References

The references relied upon by the examiner are:

Logan et al (Logan)	5,721,827	February 24, 1998
Griebenow et al. (Griebenow)	5,850,520	December 15, 1998
Austin	6,157,924	December 5, 2000 (filed November 7, 1997)

Rejection at Issue

Claims 1 through 3, 12 through 15, 33, and 77 through 80 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin.

Claims 34 through 38 and 43 through 48 stand rejected under 35 U.S.C. § 103 as being unpatentable over Logan. Claims 4 through 11, 16 through 22, 39 through 42, and 81 through 85 stand rejected under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin and Logan.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and the examiner, and for the reasons stated *infra* we sustain the examiner's rejection of claim 77 under 35 U.S.C. § 103. However, we will not sustain the examiner's rejections of claims 1 through 22, 33 through 48 and 78 through 85 under 35 U.S.C. § 103.

Grouping of the claims.

At the outset, we note that appellants' arguments group the claims in ten (10) groups. On page 4 of the brief, appellants provide a matrix depicting the claims grouped and the arguments presented with respect to the claims grouped. For clarity, we will address the independent claims and dependent claims as separately addressed by appellants' arguments.

Rejection of Independent claim 1 and the claims dependent upon claim 1.

The examiner's rejection of claim 1 as being unpatentable over Griebenow in view of Austin is set forth on pages 3 through 5 of the answer.

On pages 6 and 7 of the brief, appellants argue that neither Griebenow nor Austin, nor the combination thereof, teaches the claim 1 limitation of "storing a print schedule with an indication that the document should be printed at a user requested time." Appellants assert that contrary to the examiner's assertion, Austin, in figure 4A and the accompanying description in column 10, does not show that the user can select the frequency of delivery of the document.

In reply, the examiner states, on page 10 of the answer:

Austin discloses the user being able to modify delivery options. Figure 4D shows that one of the characteristics of the statement distribution system

is the “Delivery Frequency”, which is listed on the exemplary figure as “Monthly”. In other examples, Austin uses financial statements, such as investment reports, which as is well known, may be issued monthly, quarterly, or annually, depending on the desires of the user. Therefore, it would have been obvious at the time of the invention based on these two disclosures to delivery [sic, deliver] the electronic document at a user-specified time (e.g. monthly).

Further, the examiner asserts that “[t]he feature of letting a user designate a time or frequency for delivery of a newspaper, a publication, a report, a financial statement, etc. has been well known in the society for decades, if not for centuries.”

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and arguments.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “[T]hus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). When determining obviousness, “[t]he factual inquiry whether to combine references must be thorough and searching.” *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, *citing McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). “It must be based on objective evidence of record.” *Id.* “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50

USPQ2d 1614, 1617. “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). The Federal Circuit states that, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, our reviewing court stated, that when making an obviousness rejection based on combination, “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant” in *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433 (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

We disagree with the examiner’s rationale. Claim 1 includes the limitations “storing a print schedule with an indication that the document should be printed at a user requested time.” The examiner’s rejection has not provided any objective evidence that teaches or suggests the feature of allowing the user of Austin’s system to change the delivery time or frequency of documents.

Figures 4A and 4D of Austin depict displays whereby a user of Austin’s system can change the delivery options for receiving future statements. As described in column 10, lines 17 through 22, the screen allows the user to select “the delivery

medium (i.e. e-mail, Excel® spreadsheet, Microsoft MS Money®, fax, print) in which to receive statements in.” However, we find no disclosure in Austin, which teaches or suggests that the user can change the delivery frequency of the document. Further, we find that the examiner’s statement that “the feature of letting a user designate a time or frequency for delivery … has been well known” is unsupported by objective evidence of record.

It is unclear, from the examiner’s rejection on page 3 of the brief, if the examiner is asserting that Griebenow teaches allowing the user to change the delivery time or frequency of documents. We find that Griebenow teaches a system where a user can order documents to be delivered immediately or periodically. See column 4, lines 20-31. Inasmuch as a user requesting immediate delivery of a document can be considered to be selecting a delivery time, we consider the act of requesting immediate delivery to be a user intervention. Thus, the act of requesting immediate delivery does not meet the additional claim 1 limitations of “automatically requesting, without user intervention, the document based on the print schedule; causing automatic printing, without user intervention, the document on the printing device.”

Thus, we find that the examiner has neither presented objective evidence that it was known at the time of appellants’ invention to allow a user to designate a time frequency of delivery of a document, nor shown that the references of record provide any suggestion to modify either reference in order to incorporate such a feature. Accordingly, we will not sustain the examiner’s rejection of claim

1 or the examiner's rejection of claims 2, 3, 12 through 15, and 33, which ultimately depend upon claim 1, under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin.

Claims 4 through 11 and 16 through 22 also ultimately depend upon claim 1. The examiner's rejection of claims 4 through 11 and 16 through 22 under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin and Logan is set forth on pages 7 and 8 of the answer. The examiner does not assert, nor do we find, that Logan teaches or suggests the claim 1 limitation of "storing a print schedule with an indication that the document should be printed at a user requested time." Accordingly, we will not sustain the examiner's rejection of claims 4 through 11 and 16 through 22 for the reasons stated *supra* with respect to independent claim 1.

Rejection of Independent claim 34 and the claims dependent upon claim 34.

The examiner's rejection of claims 34 through 38 and 43 through 48 as being unpatentable over Logan, is set forth on pages 6 and 7 of the answer. The examiner's rejection of claims 39 through 42 over Griebenow in view of Austin and Logan, is set forth on page 8 of the answer.

Appellants assert, on pages 9 and 10 of the brief, that Logan is concerned with monitoring an audio device instead of a printing device as claimed and that Logan provides no teaching or suggestion to monitor a printer.

In response, on pages 11 and 12 of the answer, the examiner states:

The Examiner notes that in the final rejection it was noted that Logan monitored the usage of an audio device connected to the network in order

to give credit to the subscriber (user) to reduce the cost of the audio files being delivered to the subscriber, as cited by the Appellant in the Brief. It was further noted that both Logan's audio device and the Appellant's printer were network output devices which were being used to deliver an electronic document to the user, and that the method steps disclosed by Logan could be used to monitor any type of network output device to include a printer, an audio device, a video device, a computer, a copier, or a fax machine. It was also noted that Logan disclosed that the files being downloaded (i.e. electronic document) could contain audio, text, or both. Thus, while an audio file may be delivered through an audio device, a text file would either need to be converted into an audio file or else be delivered through another output device such as a video display or printer. Therefore, the Examiner considered it obvious to one having ordinary skill in the art to also use the method steps in Logan to monitor theses other output devices to include a printer in order to facilitate the correct billing of the subscriber as taught by Logan.

We disagree with the examiner's rationale. Claim 34 includes the limitation of "monitoring by a document server the usage of a printing device; and subsidizing the purchase of a product, based on the electronically monitoring step." We concur with the examiner that Logan teaches a system of monitoring an audio device which provides credits to subscribers. We also concur with the examiner's findings that Logan teaches that the electronic content can be in the form of either audio files or text files. We disagree with the examiner that one of ordinary skill in the art would have found it obvious to use Logan's method to monitor a printer. Our reviewing court has said, "[t]he motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Huston* 308 F.3d 1267, 1280, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002, citing *In re Kotzab* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed.

Cir. 2000). Logan teaches that when the data is in text form, it is converted to audio form, thus we find no direct motivation to modify the device to be used with a printer. See column 4, lines 57 through 60. Further, Logan teaches that the purpose of the audio device is to provide audio information to people who are traveling and are confined in vehicles, such as their automobiles for periods of time. See column 1, lines 26-30, column 6, lines 19 and 30-32. Thus, we do not find that the nature of the problem to be solved provides motivation to modify the reference. Accordingly, we will not sustain the examiner's rejection under 35 U.S.C. § 103 of claims 34 through 38 and 43 through 48 as being unpatentable over Logan.

Claims 39 through 42 are ultimately dependent upon claim 34 and stand rejected under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin and Logan. The examiner has not asserted, nor do we find, that either Griebenow or Austin, teaches or suggests modifying Logan to monitor by a document server, a printing device as claimed in independent claim 34. Accordingly, we will not sustain the examiner's rejection of claims 39 through 42 under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin and Logan.

**Rejection of Independent claim 77 and the claims
dependent upon claim 77.**

The examiner's rejection of claim 77 as being unpatentable under 35 U.S.C. § 103 over Griebenow in view of Austin, is set forth on pages 3 through 5 of the answer.

Appellants argue on page 12 of the brief that the passages of Griebenow cited by the examiner contain a lot of information but that none of it is related to "updating the user profile with an indication that the document printed successfully" as claimed in claim 77. Further, appellants argue:

Griebenow does disclose elsewhere in their specification that a "return receipt" may be requested when the electronic document has been delivered, and that this receipt is "stored in storage 60",^[1] but fails to disclose, teach, or suggest that this "return receipt" can indicate that "the document printed successfully", or that a "user profile" is updated with this information, as Appellants are claiming. (footnote omitted)

Further, on page 13 of the brief, appellants' argue:

Austin does appear to disclose verification of successful delivery of the document to the user, and verification that the correct medium (such as a document to be printed) was used. But a closer reading of Austin shows that Austin does not go so far as to disclose, teach, or suggest a way of knowing that the document was successfully delivered to the printer and actually printed, and therefore does not disclose, teach, or suggest a way of determining that the "document printed successfully", as Appellants are claiming. Moreover, while Austin's customer file could be construed to be a "user profile", a close reading of the cited portions of the Austin reference does not indicate that Austin discloses, teaches, or suggests the ability of "updating the user profile with an indication that the document printed successfully", as Appellants are claiming.

The examiner replies to the appellants' arguments on page 12 of the answer explaining how the examiner considers Griebenow's teaching of a return receipt meet appellants' claimed updating of the user's profile. Further on pages 12 and 13 of the answer, the examiner states:

[1]It would have been obvious to one of ordinary skill in the art that when verifying that the document has been delivered to or received by the consumer to ensure that it was successfully delivered (to the correct delivery system, e.g. a printer), since the advertiser is being billed for the delivery of their advertisement to the consumer. This is also explicitly

shown in Austin as cited by the Appellant[s]. Successful delivery to a printer would be verification that the printer successfully printed the document. Such printer monitoring means and methods are well known in the art and have been used extensively to monitor queues of documents assigned to network printers for at least the past two decades. When a document has been delivered to a printing queue, but its printing is unsuccessful (possible [sic, possibly due] to an “out of paper” situation) an Error Message is usually sent to the system manager or other monitoring person/device/log. Thus, not only was it common to verify the delivery, but also to verify the printing of documents sent to a printer.

We concur with the examiner. For the reasons stated by the examiner on page 12 of the answer, we find that Griebenow teaches updating a user profile upon successful delivery of the electronic document. In combination with Austin, which teaches that electronic documents can be delivered to printers, we consider this to suggest updating to reflect successful printing, if that is the method of delivery selected by the user. Further, as the examiner and appellants note, Austin, in column 13, lines 10-15, teaches that verification is performed to insure that all of the information was delivered and delivered in the correct medium. We consider that Austin’s teaching of verifying delivery of a document that is to be delivered via a printer to mean verification that it was printed, i.e. if the user selected the printer as the delivery medium, and the document was not printed the document is not delivered until it is printed. Accordingly, we sustain the examiner’s rejection of claim 77 under 35 U.S.C. § 103.

We next consider the examiner’s rejection of claim 78 under 35 U.S.C. § 103 as over Griebenow in view of Austin.

On page 14 of the brief, appellants argue that the rejection of claim 78 is improper for the reasons stated with respect to claims grouped with claim 1 (appellants' claim group 1) and claims grouped with claim 77 (appellants' claim group III).

We concur with appellants. Though we are not convinced by appellants' arguments with respect to claim 77, claim 78 contains limitations similar to limitations in claim 1. Claim 78 is dependent on claim 77 and adds the limitation "wherein the print schedule further comprises an indication that the document should be printed at a user requested time." As discussed *supra* with respect to claim 1, we do not find that the combination of Griebenow and Austin teaches or suggests a print schedule with an indication that the document should be printed at a user requested time. Thus, we will not sustain the examiner's rejection of claim 78 under 35 U.S.C. § 103. Claims 79 and 80 are dependent upon claim 78, similarly, we will not sustain the examiner's rejection of claims 79 and 80.

**Rejection of Independent claim 81 and the claims
dependent upon claim 81.**

The examiner's rejection of claims 81 through 85 Griebenow in view of Austin and Logan, is set forth on page 8 of the answer.

Appellants argue, on pages 14 through 17 of the brief, that the rejection of claim 81 is improper for the reasons asserted with respect to claim 34 and also because the combination of the references does not teach "subsidizing the purchase of a product that is depleted upon the usage of the printing device" as is claimed in claim 81.

We concur with appellants. Independent claim 81 includes the limitations “electronically monitoring by a document server the usage of a printing device; and subsidizing the purchase of a product that is depleted upon the usage of the printing device, based on the electronically monitoring step.” As stated *supra* with respect to claim 39, we do not find that the combination of Griebenow, Austin and Logan teaches monitoring by a document server, a printing device. Accordingly, we will not sustain the examiner’s rejection of claims 81 through 85 under 35 U.S.C. § 103 as being unpatentable over Griebenow in view of Austin and Logan.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellant did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

Summary

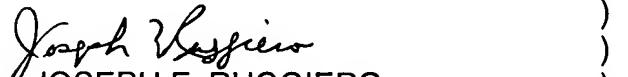
In summary, we will not sustain the examiner's rejections of claims 1 through 22, 33 through 48 and 78 through 85 under 35 U.S.C. § 103. However, we sustain the examiner's rejection of claim 77 under 35 U.S.C. § 103. The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART



ERROL A. KRASS
Administrative Patent Judge



JOSEPH F. RUGGIERO
Administrative Patent Judge

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BOARD OF PATENT
APPEALS AND
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ROBERT E. NAPPI
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